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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,700	01/28/2004	Buell Andrew Pratt	092807.011500	8931
33717 7590 10/17/2007 GREENBERG TRAUIG LLP (LA) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404			EXAMINER LEE, JOHN W	
			ART UNIT 2624	PAPER NUMBER
			MAIL DATE 10/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/766,700	Applicant(s) PRATT ET AL.	
	Examiner John Wahnkyo Lee	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2007 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20070128</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26, drawn to a method for consolidating a plurality of media segments, classified in class 386/subclass 4.
- II. Claims 27-37, drawn to an archive of a plurality of media segments, classified in class 382/subclass 305.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as a method for consolidating a plurality of media segments in a physical and a recording way. Subcombination II has separate utility such as an archive of a plurality of media segments. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to

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provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

5. Applicant's election without traverse of group II in the reply filed on 13 September 2007 is acknowledged.

Information Disclosure Statement

6. An initialed and dated copy of Applicant's IDS forms 1449, Paper No. 20040128, is attached to the instant Office action.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 27-37 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claims 27-37, while defining an archive, does not define a "computer-readable medium" and is thus non-statutory for that reasons. An archive can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Regarding claim 37, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). In claim 37, the applicant uses the phrase, "such that" which can be equivalent to "such as."

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims rejected under 35 U.S.C. 102(e) as being anticipated by Reber et al. (US 6,636,869).

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Regarding claim 27, Reber discloses an archive (abstract, "media data") of a plurality of media segments (abstract, "piece of media") from a motion picture (Fig. 1, "VTR'S & OTHER Media SOURCES") comprising:

a roll formed by winding (Fig. 1; col. 3, lines 48-50, "VTRs") the plurality of media segments (col. 1, lines 42-58, "clips"), each segment spliced to another of the segments, wherein each segment has a location within said roll and a first information (claim 7, ".. originates ..."); and a database (Fig. 1, "Media Database"; claim 7) having a record for each segment associating the location of the segment within said roll, with said first information (claim 7); whereby said database provides said first information and the associated location in said roll of the plurality of media segments (claim 7); and whereby the physical volume required to store said plurality of media segments is reduced and the accessibility of said plurality of media segments is maintained (Fig. 1, "digitizing"; col. 3, lines 48-55, "It is inherent that if the VTR's data is digitized and stored on a hard disk drive, then the segments will be reduced and it will maintain or increase the accessibility of the data via computer").

Regarding claim 28, Reber discloses that the first information is comprised of at least one of a key number associated with a first end of the segment, a splice designation, and a note labeling the segment (abstract, "labels").

Regarding claim 29, Reber discloses that wherein one of the segments has a frame, said frame having a second information and a location in said roll (claim 7); said database further having a record associating the location of said frame with said second

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information; whereby said database provides said second information and the location in said roll associated with the frame (claim 7, "a time range ...").

Regarding claim 30, Reber discloses that the consolidated archive of claim 29, wherein said second information comprises at least one of a key number, a slate record, a flash frame designation, and a wave designation (col. 8, lines 33-44, "unique identifier").

Regarding claim 31, Reber discloses further comprising: a digitized media file of said plurality of file segments ((Fig. 1, "digitizing"; col. 3, lines 48-55), said media file having a substantial correspondence to said roll (claim 7); whereby said database, from the location in said roll of said frame, identifies a portion of said media file substantially representative of said frame (claims 15-18).

Regarding claim 32, Reber discloses further comprising: a digitized media file of said plurality of file segments ((Fig. 1, "digitizing"; col. 3, lines 48-55), said media file having a substantial correspondence to said roll (claim 7); whereby said database, from the location in said roll of said frame, identifies a portion of said media file substantially representative of said frame (claims 15-18).

Regarding claim 33, Reber discloses that wherein one of the segments has a frame (claim 7), said frame having a second information and a location in said roll (claim 7); said database further having a record associating the location of said frame with said second information (claim 7); whereby said database provides said second information and the location in said roll associated with the frame (claim 7); and whereby said

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database, from the location in said roll of said frame, identifies a portion of said media-file substantially representative of said frame (claims 15-18).

Regarding claim 34, Reber discloses further comprising: a client (col. 4, line 50); a media server having access to said media file (Fig. 1, col. 4, lines 26-67; col. 5, lines 1-10); and a network (Fig. 1, col. 4, lines 26-67; col. 5, lines 1-10); said network connecting said client to both said database and said media server (Fig. 1, col. 4, lines 26-67; col. 5, lines 1-10); thereby providing said client with communication to both said database and said media server (Fig. 1, col. 4, lines 26-67; col. 5, lines 1-10); at least one of said database and said client further having a means for selecting from the media server a portion of the media file to be provided to the client (col. 4, lines 50-53); said client comprising a means for searching the database (col. 4, lines 50-53); a means for displaying results provided by the database (claims 58 and 170); and a means for displaying the portion of the media file provided by the media server (claims 58 and 170); whereby the accessibility of said plurality of media segments is increased (col. 4, lines 50-53).

Regarding claim 36, Reber discloses that wherein said media file is suitable for use by a non-linear editing station (col. 1, lines 42-65).

Regarding claim 37, Reber discloses wherein the client further comprises: a first means for indicating to said database a portion of said roll and a format for delivery (col. 4, lines 25-67; col. 5, lines 1-10); said database responsive to said first means, such that an order is generated to prepare said portion of said roll according to the

format; whereby a user of the client can order the media segments from the consolidated archive (col. 4, lines 25-67; col. 5, lines 1-10).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 6,636,869) in view of Hoffert et al. (US 2001/0014891).

Regarding claim 35, Reber discloses all the previous claim limitations except the one recited in claim 35. However, Hoffert discloses that said media file is streaming media (paragraph [0082]).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to use Hoffert's invention in Reber's invention to provide dynamic linking or binding as suggested by Reber (col. 2, lines 45-46).

Conclusion

14. No claims are allowed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Wahnkyo Lee whose telephone number is (571)

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272-9554. The examiner can normally be reached on Monday - Friday (Alt.) 7:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John W. Lee
(AU 2624)

JINGGE WU
SUPERVISORY PATENT EXAMINER

